

ESTTA Tracking number: **ESTTA358240**

Filing date: **07/15/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052637
Party	Plaintiff Vidtel, Inc.
Correspondence Address	LYNN M. HUMPHREYS MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482 UNITED STATES lhumphreys@mofo.com, jkripke@mofo.com, dpung@mofo.com, mmcdaniel@mofo.com
Submission	Other Motions/Papers
Filer's Name	Lynn M. Humphreys
Filer's e-mail	lhumphreys@mofo.com, jkripke@mofo.com, dpung@mofo.com, mmcdaniel@mofo.com
Signature	/Lynn M. Humphreys/
Date	07/15/2010
Attachments	64587-6001.501 - ttab - Notice of Ineffective Service.pdf (17 pages)(4856745 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VIDTEL, INC.,
Petitioner,

vs.

SANTA CRUZ NETWORKS, INC.,
Respondent.

Cancellation No.: 92052637
Registration No.: 2,927,795
Issued: February 22, 2005
Mark: VIDTEL
(stylized)

NOTICE OF INEFFECTIVE SERVICE OF PETITION TO CANCEL

Box TTAB FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Ms. Linnehan:

Vidtel, Inc. ("Petitioner") files this notice in accordance with 37 C.F.R. §2.111(b). Petitioner hereby gives notice to the Board that Petitioner's attempt to serve a copy of the Petition to Cancel U.S. Registration No. 2, 927,795 on Santa Cruz Networks, Inc. ("Respondent"), in compliance with 37 C.F.R. §2.111(b) and 37 C.F.R. § 2.119(a), was ineffective. Petitioner's duty to attempt to serve a notice of the Petition to Cancel has been discharged.

A copy of the Petition to Cancel was served on Respondent by depositing the document with the United States Postal Service with postage thereon fully prepaid for collection and mailing on June 28, 2010. A true and correct copy of the proof of service by mail declaration signed by Mary S. McDaniel is attached herein as Exhibit A. The copy of the Petition to Cancel was sent to the address of the owner listed for U.S. Registration No. 2,927,795. A true and

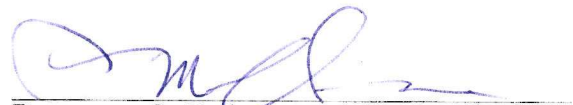
correct copy of printout of the TARR system status report for U.S. Registration No. 2,927,795 is attached herein as Exhibit B. The service copy was returned and received marked "Return to Sender" on July 7, 2010. A true and correct copy of the returned envelope and the returned service copy are attached herein as Exhibit C.

WHEREFORE, Petitioner's duty to attempt to serve notice has been discharged.

Respectfully submitted,

Dated: July 15, 2010

By:



Rosemary S. Tarlton
Lynn M. Humphreys
Attorney for Applicant

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6327
Facsimile: (415) 268-7522

EXHIBIT A

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on June 28, 2010, I served a copy of:

PETITION TO CANCEL

on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

**Santa Cruz Networks, Inc.
603 Mission Street
Santa Cruz, CA 95060**

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 28th day of June 2010.

Mary S. McDaniel
(typed)


(signature)

EXHIBIT B

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-07-13 21:55:36 ET

Serial Number: 78258362 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2927795

Mark



(words only): VIDITEL

Standard Character claim: No

Current Status: A cancellation proceeding has been filed at the Trademark Trial and Appeal Board and is now pending.

Date of Status: 2010-06-29

Filing Date: 2003-06-04

Transformed into a National Application: No

Registration Date: 2005-02-22

Register: Principal

Law Office Assigned: LAW OFFICE 116

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-02-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Santa Cruz Networks, Inc.](#)

Address:

[Santa Cruz Networks, Inc.](#)

603 Mission Street
Santa Cruz, CA 95060
United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 038

Class Status: Active

electronic and digital transmission of voice, data, images, signals, and messages; web messaging services; audio, video, and text messaging services offered via electronic communications networks

Basis: 1(a)

First Use Date: 2003-05-27

First Use in Commerce Date: 2003-05-27

ADDITIONAL INFORMATION

Design Search Code(s):

26.05.13 - Triangles, exactly two triangles; Two triangles

26.05.21 - Triangles that are completely or partially shaded

26.05.25 - Triangles with one or more curved sides

27.03.01 - Geometric figures forming letters, numerals or punctuation

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-06-29 - Cancellation Instituted No. 999999

2005-02-22 - Registered - Principal Register

2004-11-30 - Published for opposition

2004-11-10 - Notice of publication

2004-10-01 - Case File In TICS

2004-09-27 - Law Office Publication Review Completed

2004-09-24 - Assigned To LIE

2004-09-20 - Approved for Pub - Principal Register (Initial exam)

2004-09-20 - Assigned To Examiner

2004-09-17 - Amendment From Applicant Entered

2004-08-30 - Communication received from applicant

2004-08-30 - PAPER RECEIVED

2004-07-19 - LETTER OF SUSPENSION E-MAILED

2004-06-14 - Amendment From Applicant Entered

2004-06-14 - Communication received from applicant

2004-06-14 - PAPER RECEIVED

2003-12-10 - Non-final action e-mailed

2003-12-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Susan E. Hollander, Esq.

Correspondent

SANTA CRUZ NETWORKS, INC.
603 MISSION STREET
SANTA CRUZ, CA 95060
Phone Number: (650)812-1300
Fax Number: (650)213-0260

EXHIBIT C

MORRISON | FOERSTER

47

Santa Cruz Networks, Inc.
603 Mission Street
Santa Cruz, CA 95060

Susan McDaniel

ZIP 94105
041L11215843

neopost
06/28/2010
USPS/GE \$00.61



(MSM9/13420) (4587-6001501

950603054265482

NIXIE 951 CE 1 84 07/03/10
RETURN TO SENDER
NOT DELIVERABLE AS ADDRESSED
UNABLE TO FORWARD
BC: 94105248293 *1055-02354-01-20



RECEIVED

JUL 07 2010

TRADEMARK
Docket No. 64587-6001501

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VIDTEL, INC.,

Petitioner,

v.

SANTA CRUZ NETWORKS, INC.,

Respondent.

Cancellation No.:

Registration No.: 2,927,795

Issued: February 22, 2005

Mark: VIDITEL
(stylized)

PETITION TO CANCEL

Box TTAB FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Vidtel, Inc. ("Petitioner"), a Delaware corporation with offices at 825 E. Middlefield Road, Mountain View, California, 94043 believes that it has been, is, and will continue to be injured by Registration No. 2,927,795, and hereby applies for cancellation of the same.

To the best of Petitioner's knowledge, the name and address of the current owner of Registration No. 2,927,795 is Santa Cruz Networks, Inc. ("Respondent"), 603 Mission Street, Santa Cruz, California 95060.

The grounds for cancellation are as follows:

1. On February 22, 2005, Registration No. 2,927,795 issued for Respondent's VIDITEL (stylized) mark in connection with "electronic and digital transmission of voice, data, images, signals, and messages; web messaging services; audio, video, and text messaging services offered via electronic communications networks" in Class 38.

2. On January 30, 2009, Petitioner applied for registration in the United States of its mark, VIDTEL, Application Serial No. 77/660,077, in connection with “video telephones” in Class 9 and “telecommunication services, namely, local and long distance telephone services; local and long distance video telephone services; voicemail, video mail and video messaging services; electronic transmission of voice and video by means of video telephone” in Class 38.

3. The Examining Attorney refused to register Petitioner’s VIDTEL mark under section 2(d) of the Lanham Act, citing Respondent’s Registration No. 2,927,795 for VIDTEL (stylized).

4. On information and belief, Respondent is not using the VIDTEL (stylized) mark in commerce. Attached hereto as Exhibit A is a printout from www.archive.org of Respondent’s website, which indicates that Respondent stopped using the VIDTEL (stylized) mark on its goods and services as of January 31, 2006.

5. On information and belief, Respondent has not used the VIDTEL (stylized) mark in commerce for at least the last three consecutive years, immediately preceding the filing date of this Petition, and such nonuse constitutes prima facie abandonment of the VIDTEL (stylized) mark. On information and belief, Respondent has abandoned all use of the VIDTEL (stylized) mark without any intent to resume such use.

6. Petitioner believes that it will be seriously injured if the Respondent is permitted to retain the registration sought herein to be canceled because Respondent will retain a prima facie exclusive right to the mark VIDTEL (stylized) and will prevent the publication and subsequent registration of Petitioner’s application for VIDTEL, as it has already done. Petitioner seeks cancellation of Registration No. 2,927,795 on this basis.

WHEREFORE, Petitioner prays that Registration No. 2,927,795, currently owned by Respondent, be canceled.¹

¹ Pursuant to Trademark Rule 2.111(b), Petitioner serves this Petition to Cancel on the owner of Registration No. 2,927,795, as listed in the United States Patent & Trademark Office records.

Filing Fee: The United States Patent & Trademark Office is authorized to charge \$300.00 for the filing fee and any additional fees that may be required, or to credit any overpayment, to **Deposit Account 03-1952 (Reference No. 64587-6001501)**.

Respectfully submitted,

Dated: June 28, 2010

By: 

Rosemary S. Tarlton
Lynn M. Humphreys
Attorney for Petitioner

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-7000
Facsimile: (415) 268-7522

EXHIBIT A



Please note that the Viditel service has been discontinued on January 31, 2006. If you already have an account you should have received a notice detailing the closure.

Santa Cruz Networks is phasing out Viditel so that we may focus our efforts on enhancing our next generation VoIP and video product called Festoon. A free service featuring secure group voice, video, and sharing, Festoon plugs into existing IM platforms like Skype and Google Talk with support coming soon for AOL, MSN, and Yahoo!



For your future meetings, we welcome you to try Festoon (<http://web.archive.org/web/20060412004001/http://www.festooninc.com/>).

Wishing you the best for your online communication needs.

The Team at Santa Cruz Networks / Festoon

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

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**Santa Cruz Networks, Inc.
603 Mission Street
Santa Cruz, CA 95060**

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 28th day of June 2010.

Mary S. McDaniel
(typed)


(signature)

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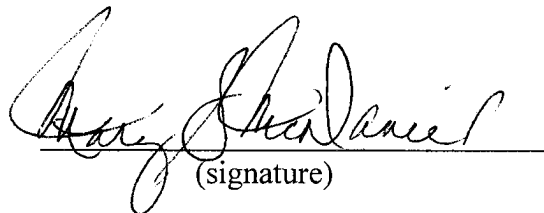
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**Santa Cruz Networks, Inc.
603 Mission Street
Santa Cruz, CA 95060**

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 15th day of July 2010.

Mary S. McDaniel
(typed)



(signature)